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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,324	11/28/2000	Steven R. Leong	0152.210US	5894

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MAXYGEN, INC.  
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EXAMINER
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SMITH, CAROLYN L

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 02/14/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/725,324

Applicant(s)

LEONG ET AL.

Examiner

Carolyn L. Smith

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-183 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-183 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Restriction/Election***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-36, 75-76, 82-83, 85-122, 161-162, 168-169, and 171-172, drawn to a nucleic acid, cell, vector, and composition, classified in class 536, subclass 23.1, and class 435, subclasses 325 and 320.1. If this Group is elected, then the below summarized sequence election is also required.
- II. Claims 37-62, 84, 123-148, and 170, drawn to a polypeptide and composition, classified in classes 530, subclass 350. If this Group is elected, then the below summarized sequence election is also required.
- III. Claims 63-64 and 149-150, drawn to an antibody or antisera, classified in class 530, subclass 387.1. If this Group is elected, then the below summarized sequence election is also required.
- IV. Claims 65-66 and 151-152, drawn to a method of producing a polypeptide, classified in class 435, subclass 69.1. If this Group is elected, then the below summarized sequence election is also required.
- V. Claims 67-68 and 153-154, drawn to a method of inducing proliferation of T-lymphocytes, classified in class 514, subclass 2. If this Group is elected, then the below summarized sequence election is also required.

Art Unit: 1631

- VI. Claims 69-70 and 155-156, drawn to a method of inducing production of IFN-gamma in T-lymphocytes, classified in class 514, subclass 2. If this Group is elected, then the below summarized sequence election is also required.
- VII. Claims 71-72, 77-78, 81, 157-158, 163-164, and 167, drawn to a method for making a modified or recombinant nucleic acid, classified in class 435, subclass 91.1. If this Group is elected, then the below summarized sequence election is also required.
- VIII. Claims 73-74, 79-80, 159-160, and 165-166, drawn to a nucleic acid library and composition, classified in class 536, subclass 23.1. If this Group is elected, then the below summarized sequence election is also required.
- IX. Claims 173-180, drawn to a computer readable medium, classified in class 211, subclass 41.12. If this Group is elected, then the below summarized sequence election is also required.
- X. Claims 181-183, drawn to a method of using a computer system to present information, classified in class 702, subclass 19. If this Group is elected, then the below summarized sequence election is also required.

**Sequence Election Requirement Applicable to All Groups:**

In addition, each Group detailed above reads on patentably distinct sequences. Each sequence is patentably distinct because they are unrelated sequences, and a further restriction is applied to each Group. For an elected Group drawn to amino acid/polypeptide sequences, the Applicants must further elect a single amino acid/polypeptide sequence. For an elected Group drawn to nucleotide sequences, the Applicants must elect a single nucleic acid sequence (See

Art Unit: 1631

MPEP 803.04). It is noted that the multitude of sequence submissions of examination has resulted in an undue search burden if more than one nucleic acid sequence is elected, thus making the previous waiver for up to 10 elected nucleic acid sequences effectively impossible to reasonably implement. Acknowledging the nucleic acid library in Group VIII, if this Group is chosen, then Applicants are requested to elect two sequences to start the examination thereof.

MPEP 803.04 states:

Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions with the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq. Examination will be restricted to only the elected sequence. It is additionally noted that this sequence election requirement is a restriction requirement and not a specie election requirement.

The inventions are distinct, each from the other because of the following reasons:

The inventions of Groupings [I, IV, VII, and VIII], [II, V, and VI], III, and [IX and X] are independent inventions because they are directed to different chemical or entity types regarding the critical limitations therein. For Groups I, IV, VII, and VIII; the critical feature is nucleic acid. For Groups II, V, and VI; the critical feature is a polypeptide. For Group III, the critical feature is an antibody. For Groups IX and X, the critical feature is a computer. The completely

Art Unit: 1631

separate chemical and entity types of the invention Groups are often separately characterized and published in literature, thus adding to the search burden if all Groups were examined together.

Also, processing that may connect two Groups does not prevent them from being considered distinct because enough processing can result in the production of any composition from another composition as long as the processing is not limited in occurrences such as subtractions, additions, and enzymatic action. Thus, the four Groupings [I, IV, VII, and VIII], [II, V, and VI], III, and [IX and X] are independent and/or distinct invention types for restriction purposes.

Inventions in Groups I, IV, VII, and VIII are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the nucleic acid of Group I may be utilized in distinct usages as needed in Group IV for a method of producing a polypeptide, in a method for making a modified or recombinant nucleic acid as in Group VII, in a nucleic acid library or composition as in Group VIII, or alternatively, in stimulating an immune response. All of these usages are distinct as requiring distinct and different functions thereof without overlapping search due to different subject matter. This lack of overlapping searches documents the undue search burden if they were searched together.

Inventions in Groups II, V, and VI are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that

Art Unit: 1631

product (MPEP § 806.05(h)). In the instant case the polypeptide of Group II may be utilized in distinct usages as needed in Group V for a method of inducing proliferation of T-lymphocytes, in a method of inducing the proliferation of IFN-gamma in T-lymphocytes as in Group VI, or alternatively, in cell growth inhibition studies. All of these usages are distinct as requiring distinct and different functions thereof without overlapping search due to different subject matter. This lack of overlapping searches documents the undue search burden if they were searched together.

Inventions in Groups IX and X are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the computer of Group IX may be utilized in distinct usages as needed in Group X for a method of using a computer system to present information, or alternatively, in determining the three-dimensional structures of putative ligands. All of these usages are distinct as requiring distinct and different functions thereof without overlapping search due to different subject matter. This lack of overlapping searches documents the undue search burden if they were searched together.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Art Unit: 1631

Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement may be traversed (37 CFR 1.143).

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR §1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Smith, whose telephone number is (703) 308-6043. The examiner can normally be reached Monday through Friday from 8 A.M. to 4:30 P.M.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (703) 308-4028.



Art Unit: 1631

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instruments Examiner Tina Plunkett whose telephone number is (703) 305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

February 10, 2003

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER